

not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.” (Italicized emphasis in original; underlining emphasis added.)

Moreover, MPEP § 808.02 states: “Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.” (Underlining emphasis added.)

Furthermore, MPEP § 803 states: “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” (Underlining emphasis added.) It is respectfully submitted that it is clear from this MPEP section that it is PTO policy that the entire application must be searched and examined, regardless of the presence of independent or distinct inventions, if no serious burden exists. As the Examiner has not performed the analysis required by MPEP § 808.02 to establish that a serious burden exists, it is respectfully submitted that the entire application can be searched and examined without a serious burden.

Further still, it is respectfully noted that the Examiner has already searched and examined the entire application. MPEP § 811 states: “37 CFR 1.142(a), second sentence, indicates that a restriction requirement ‘will normally be made before any action upon the merits; however, it may be made at any time before final action.’ This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.”

The election of species requirement fails to satisfy the criteria for a proper restriction requirement under MPEP § 803 and MPEP § 808 because 1) the species are improperly defined according to claims, and not the various specifically different embodiments; and 2) it fails to present any analysis of why there exists a serious burden to search and examine the entire application. Accordingly, the requirement is improper and must be withdrawn.

It is also respectfully submitted that the Examiner's conclusion that claims 1, 9, 16 and 17 "contain multiple species including a transducer to power at least one of a sensor, an actuator and a control," is incorrect. Claims 1, 9, 16 and 17 do not contain multiple species as alleged by the Examiners. Each of these claims recite powering at least one of a sensor, an actuator and a control unit. Accordingly, each claim covers powering the following six combinations: (i) the sensor; (ii) the sensor and the actuator; (iii) the sensor, the actuator and the control unit; (iv) the actuator; (v) the actuator and the control unit; and (vi) the control unit. As discussed above with respect to MPEP § 806.04(e), these claims are not species, they are Applicants definitions of their invention. In addition, as also discussed above with respect to MPEP § 806.04(e), as each of the claims includes two or more of the disclosed embodiments within their breadth and scope, each of the claims is a generic or genus claim. As each claim is a generic or genus claim, Applicants are entitled to a search and examination of the full scope of each claim.

Reconsideration and withdrawal of the election of species requirement are respectfully requested.

Respectfully submitted,

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